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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/854,423

05/10/2001

Michael M. Tso

031792-0311553

7666

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7590

07/06/2010

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EXAMINER

HAVAN, THU THAO

ART UNIT

PAPER NUMBER

3695

MAIL DATE

DELIVERY MODE

07/06/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/854,423	<b>Applicant(s)</b> TSO, MICHAEL M.	
	<b>Examiner</b> THU-THAO HAVAN	<b>Art Unit</b> 3695	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-9,11-15,17-23,25-29,31-37 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11-15, 17-23, 25-29, 31-37, and 39-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **Detailed Action**

#### ***Response to Amendment***

Claims 1, 3-9, 11-15, 17-23, 25-29, 31-37, and 39-41 are pending. This action is in response to the amendment received March 22, 2010.

#### ***Response to Arguments***

The amendment overcomes the 112 and 101 issue however the rejection of claims 1, 3-9, 11-15, 17-23, 25-29, 31-37, and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 6,061,660) in view of Dethloff (US 4,968,873) is maintained. Examiner restated below.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-9, 11-15, 17-23, 25-29, 31-37, and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 6,061,660) in view of Dethloff (US 4,968,873).

Re claims 1, 15, and 29, Eggleston teaches a method for processing a transaction (col. 44, lines 40-49), the method comprising the computer implemented steps of:

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receiving, at an intermediary computer (fig. 2, element 38; An intermediary as claimed corresponds to a telecommunications connections in Eggleston since they are both a connection to link information between users), from a client device associated with a first participant in the transaction, a request to process the transaction using a first currency that is not recognized by a second participant in the transaction, wherein the client device is operatively connected to the intermediary computer via a communications link, and wherein the first currency comprises a private currency; decrementing, by the intermediary computer, an amount of the first currency associated with the first participant by decrementing a balance of a first currency account of the first participant maintained at the intermediary computer (col. 44, line 64 to col. 45, line 67; Eggleston discloses a card with userid and password wherein the user obtain incentive points to redeem the award/money at any retails. Thus one retail doesn't necessary recognize another retailers' redemption points but accepts the incentive points due to the points in the card);

incrementing, by the intermediary computer, ... by incrementing a balance of a second currency account of the first participant maintained at the intermediary computer, wherein the Second currency is recognized by the second participant; and processing the transaction using the amount of second currency associated with the first participant (col. 46, lines 4-55; Eggleston discloses the step of reducing the points in the card as awards are being granted to the user).

However, Eggleston does not explicitly teach processing the transaction using the amount of second currency associated with the first participant. On the other hand, Dethloff discloses processing the transaction using the amount of second currency associated with

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the first participant (col. 4, line 29 to col. 6, line 49). Dethloff discloses the cardholder or the issuer, after issuance or re-issuance of the card, to assign different values to one unit, change the designations of units and assign additional designation to a unit, all within the scope of the original extent of terms, and credit values initialized or reissued by the issuer(s). The capabilities of the card, namely to be assignable to sub-users (i.e. participant) and to be alterable as to the values and designations of the stored units, can be provided in individual (single) or in combinational (multi-user-value-card). Thus, it would have been obvious to one of ordinary skill in the art to process the transaction using the amount of second currency associated with the first participant when using a multi-user-value-card to assign different values to a plurality of retailers as discloses in Dethloff.

Re claims 3, 17, and 31, Eggleston teaches amount of second currency incremented by the intermediary is determined based upon at least the amount of first currency decremented by the intermediary (col. 44, line 64 to col. 45, line 67).

Re claims 4, 18, and 32, Eggleston teaches amount of second currency incremented by the intermediary is determined based upon at least a set of one or more conversion criteria (col. 21, lines 4-28). Eggleston adding or deleting prizes or changing prices or fulfillment options in the incentive points according to user's criteria in receiving the award(s).

Re claims 5, 8, 19, and 33, Eggleston teaches set of one or more conversion criteria includes a time at which the request from the first participant is received (col. 1, lines 46-62; fig. 9). Eggleston discloses the time is required to keep track of loyalty points earned in each separate incentive program.

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Re claims 6-7, 20-22, and 34-36, Eggleston teaches set of one or more conversion criteria includes one or more attributes of the first/second participant (col. 41, lines 5-38; col. 27, lines 8-34; col. 25, lines 15-49). Eggleston discloses attributes by information and criteria of retailers.

Re claims 9, 23, and 37, Eggleston teaches set of one or more conversion criteria includes which products or services are involved in the transaction (col. 41, lines 28-65; col. 42, lines 38-57).

Re claims 11, 25, and 39, Eggleston teaches decrementing the balance of the first currency account and incrementing the balance of the second currency account are performed as an atomic transaction (col. 46, lines 4-55). Eggleston calculations and printed invoices for payment by a financial institution to an incentive company based on the credit instruments issued under the incentive program are made and are dependent upon the monetary volume of expenditures.

Re claims 12-13, 26-27, and 40-41, Eggleston teaches if the transaction is not successfully processed, then incrementing the first currency associated with the first participant by the amount of first currency that was previously decremented (col. 21, lines 4-28). Eggleston discloses the retailer may elect to update the award database by adding or deleting prizes or changing prices or fulfillment options.

Re claims 14 and 28, Eggleston teaches receiving, from the first participant, a request to process a second transaction involving the first participant and a third participant using the first currency that is not recognized by the third participant; decrementing an additional amount of the first currency associated with the first participant; incrementing an amount of

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third currency associated with the first participant, wherein the third currency is recognized by the third participant; and processing the second transaction using the amount of the third currency (col. 44, line 64 to col. 45, line 67; col. 46, lines 4-55).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached from Monday to Friday at 6am-2pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Thu Thao Havan/  
Primary Examiner, Art Unit 3695

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